

REMARKS/ARGUMENTS

Claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48 and 50 stand rejected in the outstanding Official Action. Claims 18, 33, 47, 48 and 50 have been amended and therefore claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48 and 50 remain in the application. It is noted that the amendments to claims 18, 33 and 47 were previously proposed in the Amendment under Rule 116 filed April 28, 2008 with entry not permitted by the Examiner's Advisory Action mailed May 21, 2008. Entry of these amendments is now required in view of the fact that the present Official Action – the third Action in this application – is not a final rejection.

On page 2, sections 4-6 of the Official Action, the Examiner provides what he contends is his “claim interpretations.” However, it is noted that these “interpretations” may not be supported by either statutory requirements or judicial constructions of statutory requirements or even Manual of Patent Examining Procedure (MPEP) instructions. These defects in the “interpretations” will be pointed out in detail below.

The Examiner admits that claim 41 is directed to a computer and also admits that a computer “is a machine.” The Examiner correctly notes that any computer would appear to satisfy the claim limitation as stated in the preamble. The Examiner's definition that “a computer is normally claimed as a system comprising a processor functionally connected to memory containing instructions” is also very much appreciated. Applicant has no dispute as to the Examiner's definition of a computer.

However, the Examiner's suggestion that claim 41 is only limited to a computer is incorrect. As set forth in claim 41 as previously presented, the information generated or acquired during “progress of a first design project” is “according to the method described in claim 33.”

Thus, claim 41 is dependent from independent claim 33 and, as will be readily apparent to those of ordinary skill in the art, is a computer programmed to include the method steps of claim 33 as specified.

In section 5 regarding claim 48, the Examiner correctly determines that the claim is directed to “a system.” Applicant has amended claim 48 to recite a “computer system” inasmuch as the Examiner indicates that “any computer appears to satisfy the claim limitations.” However, the Examiner apparently has ignored the fact that the claimed “design rationale” that the computer system captures is the design rationale “according to the method of claim 33.” As will be discussed later, Applicant uses this “shorthand” format for claiming the design rationale containing the method steps of claim 33 without having to restate all of the steps in claim 33. As will be seen, this is proper claim construction as determined by the U.S. PTO Board of Patent Appeals and Interferences.

The Examiner contends that “operable to” appears to be an “intended use” limitation. Applicant has amended the claim to recite “configured to capture” which is a positive recitation of the interrelationship of the computer system and the other limitations of the claim. Accordingly, the Examiner’s statement “any computer appears to satisfy the claim limitations” is incorrect.

Regarding claim 50, the Examiner, similar to claim 48, correctly assesses that the claim is directed to a system. Applicant has similarly amended claim 50 to recite a “computer system” and has also dropped the language “operable to” in favor of “configured to.” These limitations are made for the same reasons that the limitations were changed in claim 48 and in view of the

fact that claim 50 is also dependent on claim 33, the above comments regarding the dependency from claim 33 are herein incorporated by reference.

The Examiner's indication of "claim interpretations" is appreciated.

On page 3, claims 18, 19, 33, 41, 47, 48 and 50 stand rejected under 35 USC §112 (second paragraph) as being indefinite. The rejection of these claims is respectfully traversed, as the Examiner has provided no support for his conclusions and especially has ignored the statutory requirements, the judicial interpretation requirements and the MPEP in making his decisions. It is also noted that the Examiner fails to provide any basis for the indefiniteness rejection of claim 19. Because of this oversight, Applicant is forced to assume that the only basis of rejection of claim 19 is its dependency from claim 18 and Applicant will address each of the rejections of claims 18, 33, 41, 47, 48 and 50 as follows.

In the Official Action at page 3, section 7(a)(i), claim 18 has been rejected. Applicant has amended claim 18 to delete the word "the" in view of the Examiner's construction of the claim for claim examination purposes. However, the Examiner's construction of the claim "a predefined issue" limits the claim to a single "predefined issue" and, as noted, the claim language actually recites "at least one predefined issue." So the claim is not limited to just a single predefined issue and a correct interpretation of the literal language of claim 18 is respectfully requested.

In the Official Action at page 3, section 7(a)(ii), claim 33 has been objected to as lacking proper antecedent basis for the phrase "said file" in the last line. Applicant has amended the last line as suggested by the Examiner to read "said one of said files." This amendment is believed to obviate any further objection to claim 33 as lacking proper antecedent basis.

In the Official Action at page 3, section 7(a)(iii), claim 41 is rejected. The Examiner correctly notes that claim 41 relates to a computer programmed “according to the method described in claim 33.” Claim 33 is a method claim reciting a series of steps, i.e., “storing” and “selecting.” The Examiner’s attention is directed to the decision of the Board of Patent Appeals and Interferences in the case of *Ex parte Porter*, 25 USPQ2d 1144, 1147 (BOPAI 1992) in which the Board indicated that having a method claim dependent on an apparatus claim or vice versa “has been an acceptable format for years.”

As the Board noted in *Ex parte Porter*, while present claim 41 could be written in independent form reciting the “storing” and “selecting” steps of claim 33, it is also acceptable to present claim 41 in a “short-hand format to avoid rewriting the particulars” of the method step in claim 33. The Board noted that it regards “a claim that incorporates by reference all of the subject matter of another claim, that is, the claim is not broader in any respect, to be in compliance with the fourth paragraph of 35 USC §112.”

Thus, there is no indefiniteness in claim 41 created by the fact that it incorporates by reference the method steps described in claim 33. Claim 41 is merely a computer implemented version which is configured to operate in the manner of claim 33. Therefore, claim 41 clearly meets the statutory requirements of a further limitation of claim 33 and is not rejectable under 35 USC §112 (second paragraph).

It will be noted that this same rejection appears to be applied by the Examiner to claims 47, 48 and 50. In each of these claims, the claims are ultimately dependent upon the method of claim 33 and therefore similarly incorporate the “storing” and “selecting” steps of method claim 33. In accordance with the Board of Patent Appeals and Interferences’ decision in *Ex*

parte Porter, the addition of this dependency does not render claims 47, 48 or 50 indefinite under the statute and any further rejection thereunder is respectfully traversed.

Claims 47, 48 and 50 also stand rejected under 35 USC §101 because the claimed invention is allegedly “directed to non-statutory subject matter.” It is noted that the Examiner has made no rejection of claim 33 as failing to recite statutory subject matter and, therefore, it clearly recites statutory subject matter. It can be assumed that claim 33 meets all requirements for “statutory subject matter” as interpreted by the U.S. PTO. It is also noted that each of claims 47, 48 and 50 ultimately depend from claim 33 and therefore if claim 33 is statutory subject matter, any claim dependent therefrom must be statutory subject matter.

However, each of claims 47, 48 and 50 has been amended to reference a “computer readable storage medium” which is a positive recitation of structure which aids in the implementation of the method of claim 33 from which each one of these claims depends. Internal U.S. Patent Office policy has held that the recitation of a computer program product which includes a “computer readable storage medium” renders statutory structure which would otherwise be considered by the PTO to be non-statutory. In addition to the internal PTO policy, the Examiner’s attention is directed to the preamble of, for example, U.S. Patent 6,836,860 which recites “a computer program product comprising a computer readable medium containing computer-readable instructions”

Accordingly, in view of the dependency of claims 47, 48 and 50 upon the statutory subject matter of claim 33, as well as the amendment of claims 47, 48 and 50 to clearly recite the existence of a “computer readable storage medium,” any further rejection of those claims as being non-statutory is respectfully traversed.

Independent claims 1 and 33 and numerous claims dependent thereon stand rejected under 35 USC §103 as being unpatentable over Conklin (“gIBIS: A Hypertext Tool for Exploratory Policy Discussion”) in view of Hirose (U.S. Patent 5,784,286) in view of Regli (“A Survey of Design Rationale Systems”). The Examiner’s rejection based upon the Conklin, Hirose and Regli combination as expanded upon in the outstanding rejection has numerous errors of law and fact as will be discussed below.

It should be initially noted that these errors have been previously addressed twice by the Applicant, first in the non-entered Rule 116 Amendment filed April 28, 2008 and again in the Supporting Statement associated with the Pre-Appeal Brief Request for Review filed May 27, 2008 (which was the basis for the PTO reopening prosecution of this application). It is again requested that the Examiner respond to all of the errors noted below so that prosecution of this application may be promptly terminated. Further, the official action includes numerous underlined portions and struck-through portions – it is unclear as to what the PTO position is – does it include the struck-through portions of discussion or have these been abandoned by the PTO. Clarification is respectfully requested.

Error #1. The Examiner’s contention that one of Conklin, Hirose and Regli teach the claim limitation “said directed link is bi-directional to permit a user to traverse the link in either direction” is simply incorrect

Beginning in section 11, page 5 of the rejection, the obviousness rejection is based upon a three-reference combination including Conklin, Hirose and Regli. Independent claims 1 and 33 specifies that the claimed invention has a “directed link” and that “said directional link is bi-directional.” The Examiner does not allege that Conklin or Regli teach the claimed “directed

link is bi-directional to permit a user to traverse the link in either direction.” In fact, the Examiner appears to admit that “Conklin does not specifically teach: . . . wherein said directed link is bi-directional to permit a user to traverse the link in either direction.” (office action, page 7, section 11, K and L). Neither Hirose or Regli are alleged to contain any disclosure of the claimed “directed link.”

While the Examiner has clearly abandoned his previous allegations that Hirose “appears” to teach the claimed “directed link” (Final Rejection, page 5, section 7 (J)(ii)), he now resorts to taking “Official Notice” that this is well known (see MPEP section 2144.03) and cites four references (Kogan, Nguyen, Weinreich and Hyman) which purportedly teach the claimed “directed link.”

With respect to the Kogan reference, the Examiner merely alleges that this teaches “bi-directional hyperlinks.” However, if the Kogan patent is reviewed, it clearly discloses bi-directional links that may have multiple endpoints, but it is unclear as to how such a system could be incorporated into a “design knowledge information capture tool” as recited in independent claim 1 or the method of claim 33.

The Kogan reference is alleged to teach “bi-directional hyperlinks” at column 4, lines 35-55 and between column 1, line 65 and column 2, line 2. The Examiner’s interpretation that Kogan has anything to do with Applicant’s claimed “directed link between selected nodes” is respectfully traversed. The reference, at column 4, merely discusses hyperlinks as being “bi-directional,” meaning it can be traversed in either direction. While such systems of course are well known, it is completely unknown to apply this aspect to a design knowledge information capture tool and there is nothing in Kogan which suggest how the general feature of the claimed

“directed link” could be applied, especially to selected nodes representing items of design knowledge stored in different files.

The Examiner’s reference to the Nguyen patent purportedly teaches “bi-directional hyperlinks” although there is nothing in Nguyen which suggests the bi-directionality. It merely teaches links from a source to an anchor which may be considered a “hyperlink” but does not suggest that it is “bi-directional.” It is certainly not bi-directional in the sense of the present invention with respect to the linking of nodes relating to “items of design knowledge stored in different files.”

Weinreich, at least in the cited portion on page 22, discloses bi-directional linking, but specifically teaches away from its use in graphical maps (see the last three lines of the section entitled “Bi-directional links.” Thus, Weinreich would clearly teach away from the application of the claimed “directed link” between selected nodes where the nodes “represent items of design knowledge stored in different files.”

Hyman does teach a file open menu and a window with a list from which selections can be made. However, the Examiner apparently cites this reference as having something to do with the bi-directional links of the present invention and yet nowhere is this disclosed or suggested.

The Examiner is reminded that the Court of Appeals for the Federal Circuit has held that “the PTO has the burden under Section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). “It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” None of the cited references teach the claimed “directed link.” It is noted that the Examiner does

not allege that Hirose discloses the claimed “directed link” as defined in the claim. In fact, none of Conklin, Hirose or Regli references is cited for teaching the claimed “directed link” which is “bi-directional to permit a user to traverse the link in either direction.”

The Examiner relies solely upon the non-cited Kogan, Nguyen, Weinreich and Hyman references as evidence purportedly showing that bi-directional links between selected nodes which represent “items of design knowledge stored in different files” is somehow common knowledge. The evidence in the citations does not support this contention by the Examiner. Again the Examiner is queried as to where he believes the claimed feature is disclosed in any cited prior art reference or in the four references cited as supporting his claim of Official Notice.

As noted above in the Federal Circuit decision above, the burden is on the Examiner to establish where each claimed structure is disclosed in a combination of prior art references and, thus far, the Examiner has failed to meet this burden. Absent a disclosure of the claimed “directed link between selected nodes” and wherein the selected nodes represent “items of design knowledge stored in different files” somewhere in the patchwork quilt of prior art references, the rejection of the independent claims and claims dependent thereon clearly fails for lack of evidence amounting a *prima facie* case of obviousness.

Error #2. The Examiner fails to provide any rationale for combining bits and pieces of the three cited references and then combining them in the manner of Applicant’s independent claims

On page 9, subsections u, v, w, the Examiner alleges a motivation for combining portions of the various references. In its recent decision, the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), held that “[t]o facilitate review [of the

reasons for combining prior art], this analysis should be made explicit.” *Id.* at 1396. The Supreme Court in its *KSR* decision went on to say that it followed the Court of Appeals for the Federal Circuit’s advice that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added, the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

In section 11(u), the recitation of benefits of the Hirose reference “cost effective, useful and inexpensive design process recorder” is alleged to be the “motivation” why one would combine Hirose with Conklin. However, these benefits have nothing to do with the elements being chosen from Hirose and combined with specific elements of Conklin. There is no indication as to why one of ordinary skill in the art would ignore the other teachings in the Hirose and Conklin references. As a result, the Examiner’s statement in section u is merely a conclusory statement reciting generic benefits, i.e., “cost effective,” “useful” and “inexpensive.” These conclusory statements do not amount to the required explicit “analysis” of the rationale for picking and choosing elements and interrelationships and subsequently combining elements from a plurality of references.

In section v, the Examiner again makes a broad sweeping conclusory statement that “to use the art of Regli with the art of Conklin” which presumably includes anything disclosed in Regli and anything disclosed in Conklin, would “provide a great aid to designers” and therefore this is the purported motivation for combining elements. Again, the Examiner simply fails to provide any reason to pick and choose the “directed link” (which he does not even allege is

disclosed in Regli) with the other elements of the Conklin reference and the Hirose reference in the manner claimed.

Furthermore, the Examiner is suggesting that he is only obligated to provide a motivation for combining elements of Hirose with the Conklin patent and then a separate motivation for combining elements of Regli with the Conklin patent. In fact, the Examiner has to provide a rationale for choosing and picking the elements taken from all three references and then combining them in the manner of Applicant's claims. There has to be some reason why the elements taken from Regli would be combined with the elements taken from Hirose and then why these elements would be combined with the elements disclosed in Conklin. The Examiner has simply provided no explicit "analysis" by which a reviewing court can conclude that he has met his burden of establishing why the elements allegedly taught in the prior art would be combined in the manner of Applicant's claims.

It is Applicant's view that the Examiner has simply utilized hindsight reasoning in picking and choosing elements from Conklin, Hirose, Regli and the purported Official Notice references and then alleging that it would be obvious to combine them in a manner which is taught only by Applicant's independent claims. This is not the standard of obviousness and the Examiner has failed to meet the test set out in KSR.

Error #3. The Examiner does not cite any portion of the Kogan, Nguyen and Weinreich references, which he alleges contains “bi-directional hyperlinks,” as teaching the claimed “directed link between selected nodes” wherein “said selected nodes represent items of design knowledge stored in different files.”

Again, while the Examiner has supplemented his previous Official Notice allegations that three prior art references teach “bi-directional hyperlinks” (see page 7, section f, ii), the Examiner ignores the language of Applicant’s claim, i.e., “said directed link is bi-directional to permit a user to traverse the link in either direction” and “wherein said selected nodes represent items of design knowledge stored in different files.” As noted above, even if there were a disclosure of “bi-directional hyperlinks” in Kogan, Nguyen and Weinreich, there is no reason for one of ordinary skill in the art to believe that the Regli reference teaches any “bi-directional” link, whether a hyperlink or the claimed “directed link” in independent claims 1 and 33.

It is the structure recited in Applicant’s claims which must be disclosed in at least one prior art reference in a combination rejection under §103. The Examiner has not indicated how or where Kogan, Nguyen or Weinreich teach Applicant’s claimed “directed link” instead of the Examiner’s hyperlink. Instead, the Examiner suggests that Applicant’s claim language is similar to a hyperlink which is disclosed in Regli and that Regli’s hyperlink is similar to bi-directional hyperlinks taught in Kogan, Nguyen and Weinreich and therefore there must be some sort of disclosure in those references which somehow relates to Applicant’s claimed invention.

If the Examiner cannot point to where or how a prior art reference teaches a “directed link between selected nodes” which is “bi-directional to permit a user to traverse the link in either direction” and “wherein said selected nodes represent items of design knowledge stored in different files” there is simply no evidentiary disclosure of that claimed element. The Examiner

is respectfully requested to either identify where this specifically claimed and defined element is disclosed in any prior art references (of the Official Notice references) or abandon this argument.

Error #4. The Examiner's use of the word "appears" evidences the misapplication of the standard of "obviousness"

Throughout the outstanding Official Action, the Examiner alleges that the prior art references "appears" to teach various claimed features. However, it should be appreciated that what the references **appear to teach** is not the standard of obviousness as set forth by the Court of Appeals for the Federal Circuit.

As noted above, the burden is on the Examiner to establish a *prima facie* case of obviousness and to do this, the Examiner must show that the prior art references **actually teach** the various claimed elements, not that they **appear** to teach elements. After the Examiner has identified where each of the claimed elements and claimed interrelationships amongst elements are clearly disclosed in each of the prior art references, then the Examiner is also obligated to provide an "explicit" analysis of a rationale for picking and choosing elements from the various references and combining them in the manner of Applicant's independent claims.

Here, the Examiner's consistent use of "appears to teach" is believed an admission that the cited references do not actually teach or disclose the elements recited in Applicant's independent claims. As noted above, the Examiner has clearly failed to provide any explicit analysis as to why or how he combines elements taken from the various references in the manner disclosed only by Applicant's independent claims. As noted above, there is simply no *prima*

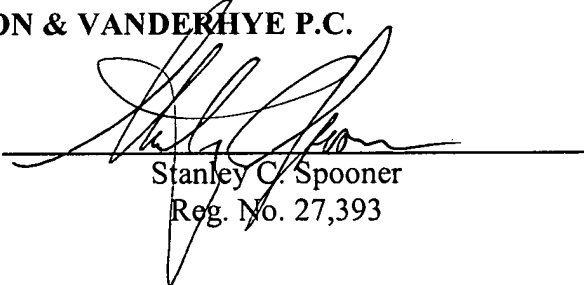
facie case of obviousness under 35 USC §103 as interpreted by any of the decisions of the Court of Appeals for the Federal Circuit.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48 and 50 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicant's undersigned representative.

Respectfully submitted,

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